

## REMARKS

Responding to the claim objections, claim 18 has been amended as requested by the Examiner.

The rejection of claims 1-7, 9, 14 and 24-35 under 35 U.S.C. 103(a) as being unpatentable over Dubno et al. (U.S. Patent No. 4,722,053, "Dubno") in view of Walker et al. (U.S. Patent No. 6,110,041, "Walker") in further view of Falciglia (U.S. Patent No. 5,971,849, "Falciglia") is respectfully traversed. Currently amended claim 1 reads:

1. (Currently Amended) In a gaming system comprising a memory, a service station and at least a first gaming location enabling play of a game by a player, apparatus for enabling communication with the service station and the first gaming location comprising:

an interactive first communication unit operable from the first gaming location including a first display visible from the first gaming location and displaying a message unrelated to play of the game without interrupting the game comprising a first menu displaying a plurality of first menu items and a second menu responsive to selection of at least one of the first menu items by the player, the second menu displaying a plurality of second selection items available for selection by the player depending on a preference of a the player stored in the memory before the second menu message is displayed at the first gaming location;

an interactive second communication unit operable from the service station, including a second display visible from the service station; and

a network arranged to transmit data so that messages are displayed on the first display and the second display.

Nothing in the cited patents, taken singly or in combination, teaches or suggests this novel apparatus with the first and second menus as claimed. The applicant also traverses several aspects of the rejection of claim 1 as follows:

The Examiner states (p. 4):

Dubno et al. lacks in disclosing a card reader and storing a player's preference prior to displaying the message and also lacks in displaying the message unrelated to the play of the game without interrupting the game.

On page 4 of the Office Action, the Examiner cites Col. 3 lines 30-54 and Col. 5, lines 1-15 of Walker. These sections teach that the preferences are used only to configure the game and are directly related to play of the game (e.g., preferred game, preferred configuration and preferred distribution of awards) as explained in Col. 5, lines 1-15. Walker fails to teach or suggest display of a message unrelated to play of the game as claimed and fails to teach that the message depends on a preference of a player stored in memory before the message is displayed at the first gaming location as claimed.

In spite of these deficiencies in the teaching of Walker, the Examiner asserts on pages 4-5 :

It is obvious to store a player preference in memory so that any game activity can be to a player's preference. Player preferences could be from how they want the display arranged to the type of personal services they enjoy. Therefore, it is obvious to store how a player wants messages received on their display prior to actually displaying any message.

Consequently, the display is varied based on the preference of a player at the gaming location.

The Examiner does not assert that it would be obvious to combine the teachings of Dubno with the teachings of Walker to arrive at the subject matter of claim 1 (as opposed to claim 9). In addition, the Examiner cites no suggestion or motivation to extend the game configuration preference selection of Walker to "any game activity." The undersigned has been unable to find any such suggestion, and there could be no motivation to extend Walker to any game activity, because Walker does not teach display of any messages unrelated to play of the game as claimed. An assertion of obviousness does not substitute for a finding of a suggestion or motivation in Walker to extend the game configuration preference selection to any game activity.

On page 5 of the Office Action, the Examiner states:

Falciglia teaches of a computer based game system in which player's chat during game play. The messages are unrelated to the game play and are displayed without interrupting the game.

Like Walker, Falciglia fails to teach that the message depends on a preference of a player stored in memory before the message is displayed at the first gaming location as claimed.

In summary, none of the applied references teaches or suggests a gaming system in which a message unrelated to play of a game depends on a preference of a player stored in memory before the message is displayed at the first gaming location as claimed.

MPEP § 2142 states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The references cited against claim 1 do meet any of the three criteria described in MPEP § 2142. Regarding the first criteria, the Examiner does not assert that it would be obvious to combine the teachings of Dubno with the teachings of Walker to arrive at the subject matter of claim 1 (as opposed to claim 9). In addition, the Examiner cites no suggestion or motivation to extend the game configuration preference selection of Walker to "any game activity." MPEP § 2143.01 states that a proposed modification cannot change the principle of operation of a reference. The Examiner asserts that it would have been obvious at the time the invention was made to use the messaging system of Falciglia (which according to the Examiner does not interrupt the game) in the game of Dubno. However, Dubno expressly teaches that a game should be interrupted during display of a menu (Col. 4, lines 32-42). Thus, the Examiner's proposed combination changes the principle of operation of Dubno, contrary to the MPEP. Claim 1 is allowable on this ground alone.

Regarding the second criteria, there is no reasonable expectation that the references could be combined with success. As previously explained, the teachings of Dubno and Falciglia are contrary with respect to interrupting the game. A person skilled in the art would therefore think that the combination would have no reasonable chance of success because Dubno specifically taught against the combination said to be obvious by the Examiner.

Regarding the third criteria, the cited references do not suggest all the claim limitations. As previously explained, at a minimum, none of the references teaches or suggests a gaming system in which a message unrelated to play of a game depends on a preference of a player stored in memory before the message is displayed at the first gaming location as claimed. In addition, none of the references teaches the first and second menus as claimed. Thus, even if the references were combined, they would not result in the claimed combination. For all the foregoing reasons, claim 1 is allowable.

An additional ground for traversing the rejection of claim 1 is found in the Examiner's reliance on what Walker et al. "could" do. On page 11 of the Office Action, the Examiner states (emphasis supplied):

While Walker does not specifically state that a player may insert their preference of how they want messages displayed it is obvious that this could a preferred feature [sic].

Relying on what prior art "could" do is contrary to the holding in *Ex parte Metcalf*, 62 USPQ2d 1633, 1635 (PTO Brd. Patent App. and Interf. 2003). For the convenience of the Examiner, a copy of the opinion is enclosed. Similarly, MPEP § 2143.01 states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Based on this decision and the MPEP, the applicant respectfully requests that the rejection of claim 1 be withdrawn.

Claims 2-7 are dependent on claim 1 and are allowable for the same reasons as claim 1.

Claim 9 is dependent on claim 1 and is allowable for the same reasons as claim 1. Currently amended claim 9 reads:

9. (Currently Amended) The apparatus of claim 1 wherein the system comprises a central authority and a card reader, the card reader being operable from the first gaming location and arranged to read a code from a card entered by the player at the first gaming location, wherein the preference is stored in the central authority, wherein the preference is accessed in response to the code, wherein the preference comprises a preference authorizing the player to be located by another player, and wherein the second display is arranged to display an identification of the location of the player in response to the code.

In the Response to Arguments, the Examiner notes that every time a player inserts his preference card into a machine, he is authorizing the casino to "track" or locate him, citing Walker Col. 6, lines 39-46. However, Walker does not teach or suggest a preference comprising authorizing the player to be located by another player as claimed in currently amended claim 9. As a result, claim 9 is allowable.

In order to support the rejection of claim 9, the Examiner relies on what Walker et al. "could" do. For example, on page 5 of the Office Action, the Examiner states (emphasis supplied):

It is obvious that the central authority could have a second display arranged to display an identification of the location of the player in response to the code on the player's card.

Relying on what prior art "could" do is contrary to the holding in *Ex parte Metcalf*, 62 USPQ2d 1633, 1635 (PTO Brd. Patent App. and Interf. 2003). Similarly, MPEP § 2143.01 states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Based on *Metcalf* and the MPEP, the applicant respectfully requests that the rejection of claim 9 be withdrawn.

Claim 24 is analogous to claim 1 and is allowable for the same reasons as claim 1. Claim 27 is analogous to claim 9 and is allowable on the same grounds as claim 9. Claim 33 also is limited to locating a first player by another player, and is allowable for the same reasons as claim 9. Claims 28 and 35 are analogous to claim 11 and are allowable on the same grounds as claim 11 as discussed below. Claims 25-26 and 29-31 are dependent on claim 24 and are allowable for the same reasons as claim 24. Claims 32 and 34 have been canceled.

The rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over Dubno in view of Walker in view of Falciglia in further view of Rapoport et al. (U.S. Patent No. 5,262,938, "Rapoport") is respectfully traversed. Claim 11 depends on claims 9 and 1. As a result, claim 11 is allowable for the same reasons as claims 9 and 1. In addition, Rapoport fails to teach a map showing the location of a player as claimed. Rapoport merely teaches a location of a table assigned to a server (Col. 3, lines 21-23). Claim 11 is allowable on this ground alone. Since claim 11 is dependent on claim 1, claim 11 is limited to a map, which is displayed based on a preference stored in memory before the map is displayed. This concept is neither taught nor suggested by any of the cited references. As a result, claim 11 is allowable on this ground alone. Another ground for traversing the rejection of claim 11 is found in the Examiner's reliance on what the cited references "could" do. On page 6 of the Office Action, the Examiner states (emphasis supplied):

It would have been obvious at the time the invention was made that the casino central server could contain a map of the location of the player.

Relying on what prior art "could" do is contrary to the holding in *Ex parte Metcalf*, 62 USPQ2d 1633, 1635 (PTO Brd. Patent App. and Interf. 2003). Similarly, MPEP § 2143.01 states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Based on *Metcalf* and the MPEP, the applicant respectfully requests that the rejection of claim 11 be withdrawn.



The rejection of claims 13, 15, 37 and 39 under 35 U.S.C. 103(a) as being unpatentable over Dubno in view of Walker in further view of Hedrick (U.S. Patent No. 6,135,884, "Hedrick") is respectfully traversed. Claims 13 and 15 are dependent on claim 1 and are allowable for the same reasons as claim 1. Claim 13 is limited to the second menu of claim 1 and is allowable for this reason alone. None of the applied patents teaches or suggests such a combination.

In the Response to Arguments (p. 12), the Examiner states:

The Examiner... notes that Hedrick clearly discloses a menu of reservation services and Walker clearly discloses storing player preferences including their likes and dislikes thus it is obvious to store only the reservation service that a player would be interested in on the player tracking card.

As noted previously, Walker does not teach or suggest storing player preferences unrelated to play of a game, and Hedrick does not teach or suggest the first and second menus as claimed. As a result, claim 13 is allowable.

Claim 15 is limited to the first and second menus of claim 1. None of the cited patents teaches or suggests such a combination. As a result, claim 15 is allowable.

Claims 37 and 39 are dependent on amended claim 24 and are allowable for the same reasons as claim 24. In addition, claims 37 and 39 are analogous to claims 13 and 15 and are allowable for the same reasons as claims 13 and 15.

The rejection of claim 38 under 35 U.S.C. 103(a) as being unpatentable over Dubno in view of Walker in further view of Hedrick in further view of Falciglia is respectfully traversed.

Currently amended claim 38 reads:

38. (Currently Amended) The method of claim 24 wherein said displaying messages visible from the first gaming location comprises displaying a menu of personal message services available, enabling the first player to enter a name of a person and a message and wherein the transmitting comprises transmitting the message to the named person.

Nothing in the applied references teaches or suggests the subject matter of amended claim 38. On page 7 of the Office Action, the Examiner states:

Falciglia, teaches of a computer-based system and method in which a player may enter a name of a person and a message to be sent to another player (See Falciglia Fig. 7).

This statement by the Examiner is respectfully traversed. Col. 7, lines 18-22 of Falciglia teaches that text may be entered by a user, and that the entered text is sent to be displayed in the stream of chat room text shown in the chat room window 42. There is no teaching or suggestion about entering the name of a person by a player as claimed. Fig. 7 shows a display in which displayed messages are only from persons identified in windows 114 and 116. Col. 7, lines 46-53 state that window 114 is a high score window and window 116 is a viewer score window. Thus, it appears that Falciglia sends the message to players appearing in windows 114 and 116, not to a person named by a player as claimed. As a result, claim 38 is allowable.

The Examiner has applied no references against claim 14 and has provided no reasons for rejecting claim 14. As a result, claim 14 is allowable. In addition, claim 14 has been amended like claim 38 and is allowable for the same reasons as claim 38.

The rejection of claims 12 and 36 under 35 U.S.C. 103(a) as being unpatentable over Dubno in view of Walker in further view of Franchi (U.S. Patent No. 5,770,533, "Franchi") is respectfully traversed. Claim 12 is dependent on amended claim 1 and is allowable for the same reasons as claim 1. Claim 36 is dependent on amended claim 24 and is allowable for the same reasons as claim 24. In addition, claims 12 and 36 are limited to a first menu displayed according to the preferences of the player, which is not taught or suggested by the applied references.

Currently amended claim 12 reads (emphasis added):

12. (Currently Amended) The apparatus of claim 1 wherein the first menu displays a plurality of types of personal service available according to the preferences of the player.

Nothing in Dubno, Walker or Franchi teaches or suggests the player preference aspect of claim 12 or the first menu. In the Responses to Argument (p. 13), the Examiner states that a reference to Walker has been added to clarify this rejection. (Actually, the prior Office Action also had a reference to Walker.) However, the Examiner does not state how Walker is sought to be combined with Dubno and Franchi, if at all. As a result, there is no basis on which the undersigned can comment on the Examiner's reasons for the rejection. The applicants respectfully request that the Examiner state the grounds for the rejection with respect to Walker, so that they can respond in a manner that will move prosecution forward.

Claim 36 is analogous to claim 12 and is allowable for the same reasons as claim 12.

The rejection of claims 16, 17 and 40 under 35 U.S.C. 103(a) as being unpatentable over Dubno et al. in view of Walker et al. in further view of Ehrman (U.S. Patent No. 5,984,786) is respectfully traversed. Amended claim 16 is limited to (emphasis supplied):

16. (Currently Amended) The apparatus of claim 1 wherein the first gaming location is arranged to accommodate a first player and wherein the first communication unit enables entry by the first player of at least one of a name of a second player and a second player code and enables entry of a first message, the apparatus further comprising a central authority, a second gaming location arranged to accommodate a second player, an interactive third communication unit operable from the second gaming location, including a third display visible from the second gaming location, the third communication unit enabling entry by the second player of at least one of a name of the first player and a first player code and enabling entry of a second message,

Although Ehrman teaches a chat box 49 in which players type messages to each other, he does not teach or suggest the underlined features quoted above that enable entry of at least one of a name of a player and a player code by another player. Thus, even if Dubno, Walker and Ehrman were combined in the manner suggested by the Examiner, they would not result in the claimed underlined features. For this reasons alone, claim 16 is allowable.

The Examiner states on page 8 of the Office Action:

It is obvious that both in order to chat, both players must enter the name of the other player for identification purposes or as one would when writing a letter.

This statement by the Examiner is respectfully traversed. As pointed out in the Amendment After Final, a player may not want his identity revealed. There is no suggestion in Ehrman for entry of a name by another player. Although Ehrman states at Col. 7, lines 64-67 that chat box 49 utilizes a message box... into which players type messages and indicate their recipient, there is no teaching or suggestion that the indication be by entering a name. For this reason alone, claim 16 is allowable.

On page 13 of the Office Action, the Examiner states in connection with Ehrman: The Examiner ... notes that when two players are in a chat session they commonly enter the other person's name for identification purposes or as one would when writing a letter.

This statement by the Examiner is respectfully traversed. The applicants are uncertain whether the Examiner is asserting Official Notice by the above-quoted statement. Alternatively, if the Examiner's assertion is based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 CFR § 1.104(d)(2), the Examiner's assertion must be supported by an affidavit from the Examiner. The Examiner's assertion is rebutted by reference to Falciglia and Ehrman, neither of which teach or suggest entering the name of a player by another player. Thus, the prior art applied by the Examiner rebuts the Examiner's statement that entering a player's name is "common" in the gaming system field. To the extent that the Examiner is relying on Official Notice, the applicants request that the Examiner provide a reference in support

of the assertion of Official Notice under MPEP 2144.03. Based on the present record, claim 16 is allowable.

Claim 17 depends on claim 16 and is allowable for the same reasons as claim 16. In addition, claim 17 is limited to a code comprising a player ID number.

The Examiner states on page 8 of the Office Action:

It is also well known to enter the code such as an ID number, of another player in order to chat.

This statement, and a similar statement on page 13 of the Office Action, by the Examiner are respectfully traversed. The applicants are uncertain whether the Examiner is asserting Official Notice by the above-quoted statement. Alternatively, if the Examiner's assertion is based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 CFR § 1.104(d)(2), the Examiner's assertion must be supported by an affidavit from the Examiner. The Examiner's assertion is rebutted by reference to Falciglia and Ehrman, neither of which teach or suggest entering the claimed player ID number. Thus, the prior art applied by the Examiner rebuts the Examiner's statement that entering a player ID number is "well known" in the gaming system field. To the extent that the Examiner is relying on Official Notice, the applicants request that the Examiner provide a reference in support of the assertion of Official Notice under MPEP 2144.03. Based on the present record, claim 17 is allowable.

On pages 13-14, the Examiner states:

The Applicant argues that a player may not want his identity revealed.

When a player initiates a chat session they must select a user name for themselves for entry into the computer. They also must enter the names

of any other person they wish to chat with. So even though they might not want their identity revealed they must use some sort of "handle" whether it is a made up name or an ID number...

The Examiner ... notes that in order to message the other player some sort of identifying means must be input into the computer such as their name or code. It is inherent to the system that once a player enters one of the aforementioned identifications, the computer can determine the location of the other person based on the entered information.

The applicants respectfully traverse the foregoing statements. The applicants are uncertain whether the Examiner is asserting Official Notice by the above-quoted statements. Alternatively, if the Examiner's assertion is based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 CFR § 1.104(d)(2), the Examiner's assertion must be supported by an affidavit from the Examiner. The Examiner's assertion is rebutted by reference to Falciglia and Ehrman, neither of which teach or suggest entering the name of another player or entering a player ID number. Thus, the prior art applied by the Examiner rebuts the Examiner's statement that entering a player name or player ID number "must" be done in the gaming system field. To the extent that the Examiner is relying on Official Notice, the applicants request that the Examiner provide a reference in support of the assertion of Official Notice under MPEP 2144.03. Regarding the statement about some sort of identifying means, claims 16 and 17 are not directed to any sort of identifying means; they are directed only to specific forms of identifying means, namely, entering a name of another player or a

player code, neither of which are taught or suggested by the applied patents. Based on the present record, claims 16 and 17 are allowable.

Amended claim 40 is analogous to amended claim 16 and is allowable for the same reasons as claim 16.

The rejection of claims 18, 19, 21-23 and 41-48 under 35 U.S.C. 103(a) as being unpatentable over Ehrman is respectfully traversed. Currently amended claim 18 is limited to:

18. (Currently Amended) In a gaming system comprising a first gaming location and a second gaming location, apparatus for enabling communication between the first and second gaming locations comprising:

an interactive first communication unit operable from the first gaming location and arranged to accommodate a first player, the first communication unit including a first display visible from the first gaming location, enabling entry of at least one of a name of a second player and a second player code and enabling entry of a first message;

an interactive second communication unit operable from the second gaming location and arranged to accommodate a second player, the second communication unit including a second display visible from the second gaming location, enabling entry of at least one of a name of the first player and a first player code and enabling entry of a second message; and

a network arranged to transmit data resulting in display of a first menu including the first message and the name of the first player on the second display, the first menu enabling selection of a reply menu allowing the second player to enter a reply message to the first player, and the network also being arranged to transmit data resulting in



display of a second menu including the second message and the name of the second player on the first display, the second menu enabling selection of a reply menu allowing the first player to enter a reply message to the second player.

Nothing in Ehrman teaches or suggests at least the above-underlined limitations.

Claims 19 and 21-23 are dependent on claim 18 and are allowable for the same reasons as claim 18. Claim 19 reads:

The apparatus of claim 18 and further comprising a central authority arranged to identify the first gaming location in response to at least one of the name of the first player and the first player code and arranged to identify the second gaming location in response to at least one of the name of the second player and the second player code.

Ehrman does not teach or suggest the subject matter of claim 19. Since Ehrman does not teach or suggest entry of the name or a player code, Ehrman cannot locate a gaming location by means of such name or code. As a result, claim 19 is allowable.

Currently amended claim 41 is analogous to amended claim 18 and is allowable for the same reasons as claim 18. Claims 42-48 are dependent on claim 41 and are allowable for the same reasons as claim 41.

The rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over Ehrman in view of Walker is respectfully traversed. Claim 20 is dependent on claim 18 and is allowable for the same reasons as claim 18.

Currently amended claim 20 is limited to a gaming system in which a central authority identifies the first gaming location based on the code read at the first location

and data entered at the second location and identifies the second gaming location based on the code read at the second location and data entered at the first location.

Ehrman does not appear to disclose any card reader, much less a card reader and central authority with the claimed features. Walker does disclose a card reader 364 for providing an ID number and name in connection with receiving player preferences for game configuration (Figs. 10A-10B). However, there is no known part of Walker that teaches or suggests locating a gaming location based on the code read at one location and data entered from another location as claimed. Even if Ehrman and Walker were combined as suggested by the Examiner, the claimed combination would not result.

On page 14 of the Office Action, the Examiner states:

The Examiner... notes that every time the player inserts their preference card into a machine they are authorizing the casino to "track" or locate them (See Walker col. 6, lines 39-46)... every time a player inserts a player preference card as in Walker into the gaming machine, the casino knows who the player is and what machine they are playing including the location of the machine. These are features, which are inherent to any type of player tracking card.

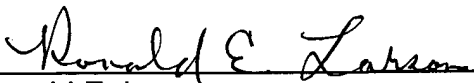
The applicants respectfully traverse this statement, because it has been superseded by the amendments made in claim 20. As a result, claim 20 is allowable.

For all the foregoing reasons, each of claims 1-7, 9, 11-31, 33 and 35-48 defines patentable subject matter, and early allowance is solicited.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: October 16, 2003

Respectfully submitted,

  
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dence of use in the relevant market, the relevant public nonetheless viewed Pacer's container cap as unique or unusual.

Pacer fails to provide any such evidence. Pacer's rebuttal consists of five affidavits signed by individuals in the business of marketing and applying artificial nail products to customers. All five affidavits are nearly identical and merely state that upon seeing Pacer's adhesive container cap, the said affiant "identif[ied] the source of the product to be Pacer Technology." As the Board noted, these affidavits, thus conclusorily worded, fail to explain what it is about Pacer's adhesive container cap that is unique or unusual, or distinctive from those of its competitors. Considering the substance of these affidavits, we conclude that there is substantial evidence that they are not the kind of "competent evidence," *id.*, that could carry Pacer's burden of rebutting the PTO's *prima facie* case. Moreover, as the Board pointed out, these affidavits, which are all signed by individuals in the artificial nail business, at most purport to represent the views of a small segment of the relevant market. The relevant market for the mark is much broader, as Pacer's cap is part of a container holding adhesives and bonding agents generally, and not simply those for artificial nails. In view of the above, we hold that Pacer has failed to rebut the PTO's *prima facie* case of no inherent distinctiveness.

### III. CONCLUSION

Substantial evidence exists as to the PTO's *prima facie* case that the adhesive container cap is not inherently distinctive and as to Pacer's failure to rebut the *prima facie* case. We therefore affirm the Board's decision sustaining the examining attorney's refusal to register Pacer's adhesive container cap on the ground of no inherent distinctiveness.

### AFFIRMED.

### COSTS

No costs.

## Ex parte Metcalf

### U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Appeal No. 2002-2049

Decided May 2, 2003

(Nonprecedential)

## PATENTS

### [1] Patentability/Validity — Obviousness — Combining references (§ 115.0905)

Mere fact that teachings found in prior art could be combined as proposed by patent examiner does not make combination obvious absent some teaching, suggestion, or incentive supporting proposed combination; in present case, examiner's obviousness rejection must be reversed, since examiner failed to identify any such teaching, suggestion, or incentive to support proposed combination of two prior art references to achieve claimed sound system invention.

Patent application of Randall B. Metcalf (no. 08/749,766). Applicant appeals from rejection of claims as obvious under 35 U.S.C. § 103(a). Reversed.

[Editor's Note: The Board of Patent Appeals and Interferences has indicated that this opinion is not binding precedent of the board.]

James G. Gatto, of Mintz, Levin, Cohn, Ferris, Glovsky & Popeo, Reston, Va., for appellant.

Before Ruggiero, Barry, and Levy, administrative patent judges.

Barry, J.

### DECISION ON APPEAL

A patent examiner rejected claims 1, 2, 4-10, 12-15, 17-19, and 21-55. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

### BACKGROUND

The invention at issue on appeal records and reproduces sounds produced concurrently by different sources. (Spec at 1.) Systems for recording and reproducing such sounds are known. In the musical context, for example, such systems record and reproduce live performances of bands and orchestras. In these

cases, musical instruments and singers' voices constitute the sources of sound. (*Id.*)

The appellant asserts that problems are encountered when trying to reproduce sound by use of loudspeakers, especially when the sound is produced by more than one source. (Appeal Br. at 2.) One such problem is associated with the phenomenon of "sound staging." Sound staging enables a listener to perceive the apparent size and location of a musical presentation. A sound stage includes the physical properties of depth and width. These properties contribute to the ability to listen to an orchestra, for example, and discern the relative positions of its instruments. (Spec. at 3.)

According to the appellant, many recording systems fail to capture precisely the sound staging effect when recording more than one source of sound. (*Id.*) One reason for this, he adds, is the methodology used by the systems. More specifically, such systems use one or more microphones to receive sound waves produced by a plurality of sources (e.g., drums, guitar, vocals) and convert the sound waves to electrical audio signals. When a single microphone is used, the sound waves from each source are mixed (i.e., superimposed on one another) to form a composite signal. When plural microphones are used, the audio signals from each are likewise mixed to form a composite signal. The appellant explains that such mixing limits the ability to recreate the sound staging of the sources. He adds, "[t]his is one reason why an orchestra sounds different when listened to live as compared with a recording." (*Id.* at 4.)

Another problem identified by the appellant occurs when a mixed audio signal is sent to a loudspeaker. More specifically, a phenomenon known as "masking" precludes the precise recreation of original sounds when they are mixed. (Appeal Br. at 3.) Masking can render one sound inaudible when accompanied by a louder sound. (Spec. at 5.) Loudspeaker masking occurs when a loudspeaker cone is driven by a composite signal as opposed to an audio signal corresponding to a single sound source. (*Id.* at 6.)

For its part, the appellant's invention features detectors for receiving sound waves from plural sources of sound and converting each of the received waves into separate audio signals without mixing. A recording mechanism separately records each of the audio signals on a recording medium. Subsequently, the stored signals are separately retrieved and provided over separate signal

paths to individual amplifiers and separate loudspeakers. (*Id.* at 9.) In summary, the audio signals are not mixed when received from the sources or when stored for recording. According to the appellant, his "invention avoids problems . . . encountered when audio signals are mixed." (Appeal Br. at 7.)

A further understanding of the invention can be achieved by reading the following claim.

1. A sound system for capturing and reproducing sounds produced by a plurality of sound sources, comprising:

means for separately receiving sounds produced by the plurality of sound sources;

means for converting the separately received sounds to a plurality of separate audio signals without mixing the audio signals;

means for separately storing the plurality of separate audio signals without mixing the audio signals;

means for separately retrieving the stored audio signals;

an amplification network comprising a plurality of amplifier means, with separate amplifier means for separately amplifying each of the separate audio signals;

a loudspeaker network comprising a plurality of loudspeaker means, with separate loudspeaker means for reproducing the separately amplified audio signals; and

a dynamic control means for individually controlling the relative amplitude of the separate audio signals for a given power level based on predetermined criteria.

Claims 1, 2, 4-10, 12-15, 17-19, and 21-55 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 3,710,034 ("Murry") and U.S. Patent No. 5,315,060 ("Paroutaud").

## OPINION

Rather than reiterate the positions of the examiner or the appellant *in toto*, we address a point of contention therebetween. The examiner admits, "Murry does not disclose that the receiving sounds are produced by the plurality of sound sources, an amplification network comprising a plurality of amplifier means, with separate amplifier means for separately amplifying each of the separate audio signals,

and a dynamic control means for individually controlling the relative amplitude of the separate audio signals for a given power level based on predetermined criteria." (Final Rejection<sup>1</sup> at 2.) He concludes, however, "it would have been obvious to combine Paroutaud's teaching with Murray [sic] because in a reproduction of music, each microphones [sic] could detect the sound of each instrument in the musical instrument and record each instrument onto a separate channel. Also, volume of each signal could be controlled and amplified separately to drive each instrument transducers [sic]." (*Id.* at 3.) The appellant argues that the examiner "has provided no teaching for such a combination, let alone any objective motivation." (Reply Br. at 3.)

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986) (citing *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). "[T]he factual inquiry whether to combine references must be thorough and searching." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). This factual question cannot "be resolved on subjective belief and unknown authority," *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002); "it must be based on objective evidence of record." *Id.* at 1343, 61 USPQ2d at 1434.

[1] Here, the examiner proposes to combine teachings of Paroutaud with those of Murry "because in a reproduction of music, each microphones [sic] could detect the sound of each instrument in the musical instrument and record each instrument onto a separate channel. Also, volume of each signal could be controlled and amplified separately to drive each instrument transducers [sic]." (Final Rejection at 3 (emphasis added).) The U.S. Court of Appeals for the Federal Circuit has stated that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972

F.2d 1260, 1266, 23 USPQ 1780, 1784 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Although this statement is couched in terms of modifying the prior art, we hold that a similar one applies to combining teachings found in the prior art. Specifically, the mere fact that teachings found in the prior art could be combined as proposed by an examiner does not make the combination obvious "absent some teaching, suggestion or incentive supporting the combination." *Carella*, 804 F.2d at 140, 231 USPQ at 647 (citing *ACS Hosp. Sys., Inc.*, 732 F.2d at 1577, 221 USPQ at 933). In the instant appeal, the examiner fails to identify any such teaching, suggestion, or incentive to support his proposed combination. Therefore, we reverse the rejection of claims 1, 2, 4-10, 12-15, 17-19, and 21-55 as obvious over the combination of Murry and Paroutaud.

## CONCLUSION

In summary, the rejection of claims 1, 2, 4-10, 12-15, 17-19, and 21-55 under § 103(a) is reversed.

## REVERSED

### Markovitz v. Camiros Ltd.

U.S. District Court  
Northern District of Illinois

No. 02C 9403

Decided June 30, 2003

## COPYRIGHTS

[1] Notice, deposit, and registration —  
Registration — Effect (§ 207.0702)

Rights in copyright; infringement —  
Ownership of copyright — Collective  
works (§ 213.0307)

Infringement pleading and practice —  
Jurisdiction (§ 217.05)

Copyright registration for book in which infringement plaintiff's artwork was published did not satisfy registration requirements of 17 U.S.C. § 411(a) for that artwork, since registration for collective work does not extend to constituent part of such work unless registrant also owns all rights in that constituent part, since "nature of authorship" section of copy-

<sup>1</sup> We advise the examiner to copy his rejections into his examiner's answers rather than merely referring to a "rejection . . . set forth in prior Office action . . ." (Examiner's Answer at 3.)